

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

TEK GLOBAL, S.R.L., et al.,

Plaintiffs,

v.

SEALANT SYSTEMS INTERNATIONAL,
INC, et al.,

Defendants.

Case No. 11-cv-00774-VC

PERMANENT INJUNCTION

I. PROHIBITED ACTIVITIES - U.S. PATENT NO. 7,789,110

IT IS HEREBY ORDERED that Defendants Sealant Systems International, Inc. and ITW Global Tire Repair (collectively, "SSI"), and any of its parents, subsidiaries, successors, assigns, officers, agents, servants, employees, attorneys, and persons or entities in active concert or participation with them (including any affiliated entities), who receive actual notice of this Permanent Injunction (collectively, the "Enjoined Parties"), are hereby permanently enjoined and restrained from infringing, or inducing or contributing to, the infringement of claims 26, 28, and 31 of U.S. Patent No. 7,789,100 (the "'110 Patent"), until the expiration of the patent, by:

(a) making, using, selling, offering to sell, or importing into the United States, any tire repair kit that includes features that infringe claims 26, 28, and 31 of the '110 Patent, including following tire-repair kit models: 70006S, 70011S, 70012S, 70013S, 70015S, 70016S, 70019S, 70022S, 70023S, 70024S, 70027S, 70028S, 70029S, 70030S, 70031S, 70032S, 70039S, 70040S, 70045S, 70006, 70011, 70016, 70019, 70023, 70024, 70027, 70028, 70029, 70030, 70031, 70032, 70039, 70040, 70041, 70045, and those no more than colorably different (collectively, "Enjoined Products"); and/or

(b) assisting others in making, using, selling, offering to sell, or importing into the United States, any Enjoined Products, by engaging in activities including, without limitation, the following: (i) advertising, marketing, or otherwise promoting Enjoined Products; (ii) entering or fulfilling product orders, or setting, determining, or approving terms of sale, for Enjoined Products; (iii) providing customer service or other technical support relating to Enjoined Products; (iv) negotiating or entering into licensing, representative, reseller, or distributor agreements relating to Enjoined Products; (v) developing, designing, manufacturing, or having manufactured products substantially similar to Enjoined Products; (vi) writing, modifying, updating, drafting or otherwise preparing documentation regarding the operation, use, or intended of any Enjoined Product.

II. SUNSET PROVISION

With respect to the Enjoined Products, the injunction against activities listed in paragraphs (a) and (b) above shall be stayed until 9 months after the date of entry of this injunction, subject to the following limitations:

(a) Sunset Sales are permitted only to existing SSI customers who (i) before March 17, 2017 qualified or validated an Enjoined Product for use in a particular customer platform; and (ii) before March 17, 2017 placed a firm order for production activities of that Enjoined Product for use in that particular customer platform. "Production quantities" are any purchases in excess of those necessary for testing and development. An infringing device sold under this Sunset Provision shall be in substantially the same design configuration as it was on March 17, 2017. Permitted Sunset Sales, if any, shall be specifically and exclusively identified in an Appendix to this Injunction, a draft of which shall be jointly submitted by TEK and SSI for the Court's consideration by August 21, 2017.

(b) For each Sunset Sale, SSI shall obtain from the purchasing customer written

certification that the purchased Enjoined Product shall be used only as specifically and exclusively identified in an Appendix to this Injunction. Such certification shall show the quantity of purchased Enjoined Products. Within 15 days after the close of each calendar quarter, SSI shall provide TEK with copies of all such certifications obtained during the immediately-preceding quarter.

III. PERMISSIBLE DESIGN-AROUND EFFORTS

Nothing in this Permanent Injunction shall prohibit the Enjoined Parties from engaging in the design, development, or testing of any product that does not infringe the '110 Patent. Nothing in this Permanent Injunction shall prohibit the Enjoined Parties from either engaging in modification of any Enjoined Product so as to eliminate infringement, or engaging in design, development, or testing for said purpose.

IV. NOTICE

IT IS FURTHER ORDERED that, within 30 days from the date of this signed Permanent Injunction, SSI shall provide a copy of this Permanent Injunction to each of its parents, subsidiaries, successors, assigns, officers, agents, servants, employees, attorneys, and persons or entities in active concert or participation with them (including any affiliated entities), as well as to any and all manufacturers, distributors, retailers, licensees, customers, automotive original equipment manufacturers, and all other persons or entities who have been, or are reasonably expected to be, directly or indirectly involved in the making, using, selling, offering for sale or importing in the United States of any Enjoined Product, including but not limited to any company to which SSI has previously directly or indirectly sold or offered for sale one or more of the Enjoined Products, and any company to which SSI intends in the future to directly or indirectly sell or offer to sell one or more of the Enjoined Products.

IT IS FURTHER ORDERED that, within 30 days from the date of this signed Permanent

Injunction, SSI shall file with the court and serve on all parties a notice stating the names and addresses of each party that it has notified in compliance with this section.

V. CONTINUING JURISDICTION

The court specifically retains jurisdiction to enforce, modify, extend, or terminate this Permanent Injunction as the equities may require, upon a proper showing, and to adopt procedures for resolution of any dispute whether a product not specifically covered by this Permanent Injunction is more than colorably different from the adjudged infringing products.

IT IS SO ORDERED.

Dated: August 11, 2017



VINCE CHHABRIA
United States District Judge